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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,165	12/11/2003	Christian Kissel	K 218	7269

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KLAUS J. BACH & ASSOCIATES
4407 Twin Oaks Drive
Murrysville, PA 15668

EXAMINER

KOTINI, PAVITRA

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/733,165

Applicant(s)

KISSEL ET AL.

Examiner

Pavitra Kotini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to applicant's amendment received on December 28, 2006. Applicant's arguments, filed on 12/28/06, with respect to the rejection(s) of claim(s) 1-11 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kimblad (US-20030153946), taking into account the amendments to claims 1 and 9.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kimblad (US-20030153946).

Kimblad discloses a medical clip comprising:

Regarding **claim 1**, a *single* platelet (6) of an elastic bio-compatible material (para.0056), said platelet being provided with a central H-shaped cut-out so as to form in the platelet a frame structure (fig.2) with tongues (16) extending toward each other and having adjacent front edges (17) forming grasping elements, said tongues extending from said frame structure and said frame structure being curved and elastically biasing said front edges toward each other (15).

Regarding **claim 2**, said tongues are bent inwardly from said curved frame structure (fig.2, 16 & 17).

Regarding **claim 3**, said tongues are bent outwardly from said curved frame structure (fig.4, 2).

Regarding **claim 4**, said elastic biocompatible material is a shape memory material (para.0056).

Regarding **claims 9**, Kimblad discloses a *single* platelet (6) of an elastic biocompatible material (para.0056), said platelet being provided with a central H-shaped cut-out so as to form in the platelet a frame structure (fig.2) with tongues (16) extending toward each other and having adjacent front edges forming grasping elements (fig.2), said tongues extending from said frame structure and said frame structure being curved and elastically biasing said front edges toward each other (fig.2, 15), an apparatus for application of a medical clip comprising of a rod (fig.4, 19) having a distal end forming a magazine body which is capable of housing *a plurality of said clips, such that the rod extends through an opening formed by bending the tongues outwardly into a spaced position (figs. 4 or 7) and holding the clips in such spaced position whereby the clips are slidably supported and a sleeve (fig.4, 21) that is movable (para.0057) so that clips can be moved off of the distal end of rod (para.0059), said rod having a distal curved front end (fig. 7, 22) so that the clips automatically slide off the rod when being moved by the sleeve to the distal curved front end.*

Regarding **claim 10**, said rod is tubular (fig.4, 19).

Regarding **claim 11**, kimblad teaches that this apparatus must be able to manure through the complex vasculature of the heart (fig.5) and therefore the sleeve (fig.3, 21) is the end of a flexible conduit (fig.3, 18) and said rod (fig.3, 19) is axially movably disposed within the flexible conduit and can be controlled remotely (para.00610) in a manner similar to a Bowden control cable because this apparatus taught by Kimblad is a flexible cable (fig.3, 18) that is used to transmit mechanical forces longitudinally by maneuvering the rod (fig.4, 19) which is situated in a hollow conduit (fig. 4, 20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimblad (US-2003/0153946) in view of Esposito (US-3616497). Kimblad discloses the invention substantially as claimed above.

Kimblad does not disclose the front edges of the tongues to be serrated or corrugated. However, Esposito teaches the front edges to have a serrated surface (fig.6, 31a) or a corrugated surface wherein there are alternating ridges and grooves in order to have better means of gripping tissue. It is old and well known in the art that having a serrated or corrugated edge would provide better traction. Therefore, it is obvious to a person of ordinary skill in the art to modify the clip disclosed by Kimblad to

include a serrated portion of the tongues as taught by Esposito to gain the advantage of having a better grip.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimblad (US-2003/0153946) in view of Reynolds. Kimblad discloses the invention substantially as claimed above.

Kimblad does not disclose the tongues to have a non-slip coating or a rough surface. However, Reynolds teaches a non-slip coating or a rough surface added to a surface of a clip (col.2, lines 16-42). This surface coating or roughened surface would have the apparent advantage of providing a better frictional surface to preventing slippage between the tongue of the clip and the material that is grasped. Therefore, it is obvious to a person of ordinary skill in the art to modify the clip disclosed by Kimblad to include a non-slip coating at the contact surface of the clip as taught by Reynolds.

Allowable Subject Matter

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/837281. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claim merely adds obvious features absent from the co-pending claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection. The reference of Kimblad discloses a platelet formed as a H-shaped cutout with tongues functioning as grasping elements. The reference of Kimblad also discloses an apparatus for application of the clip, wherein the apparatus contains a rod for holding the clips, a movable sleeve, and a curved distal

end. In essence, every structural limitation of independent claims 1 and 9 are anticipated by the reference of Kimblad.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pavitra Kotini whose telephone number is 571-272-0624. The examiner can normally be reached on M-F 8:30am to 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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AU 3731
3/9/07


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SUPERVISORY PATENT EXAMINER
0/17/07